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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/034,215	12/20/2001	Stephen L. Muench-Casanova	706126US1	7769

24938 7590 01/10/2006

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EXAMINER

CHEN, ALAN S

ART UNIT	PAPER NUMBER
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2182

DATE MAILED: 01/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/034,215

Applicant(s)

MUENCH-CASANOVA ET AL.

Examiner

Alan S. Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 8-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/28/2005 has been entered.

Election/Restrictions

2. Newly submitted claim 8-12 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

I. Claims 1-7, drawn to an invention, classified in class 713, subclass 100, particular to reconfiguration of control modules.

II. Claims 8-12, drawn to an invention, classified in class 701, subclass 1, particular to vehicle control.

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the reprogramming of a vehicle control module is purely an automotive application. The subcombination has separate utility such as for reconfiguration of generic control modules.

Since applicant has received an action on the merits for the originally presented invention (claims 1-7), this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 8-12 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

2. During a telephone conversation with Mr. Gordon Harris (Reg. No. 28,615) on 01/03/2006, Mr. Harris suggested the election of Invention II. However, in light of the previous action and prosecution already done on Invention I (claims 1-7), the applicant has in fact already elected Invention I by original presentation, per MPEP §818.02(a) and §821.03. Therefore, Invention I is elected and Invention II is hereafter withdrawn.

Response to Arguments

3. Applicant's arguments with respect to claims 1-7 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-4 are rejected under 35 U.S.C. 102(e) as being anticipated by US Pub. No. 2002/0099804A1 to O'Connor et al. (O'Connor).

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6. Per claim 1, O'Connor discloses a method of reprogramming the memory of an electronic module (Fig. 2 shows the steps of reprogramming the electronic module, here being the computer product such as a personal computer; "the memory" is the whole memory within the PC, e.g., BIOS, hard drives etc.; Fig. 2, element 22 shows programming of firmware and Fig. 2, element 42 shows programming of software/applications) comprising the steps of: down-loading a boot loader program and initializing software to a first portion of the module memory (the firmware is the first portion of the memory, it being programmed at a first step, Fig. 2, element 22) via a wired bus (Paragraphs 20 disclose programming the firmware at the beginning of the manufacturing process, e.g., when wireless protocol stack, etc, are not in place yet, hence inherently requiring traditional wired programming, e.g., via JTAG) at a first programming station (Fig. 4 and 5 show assembly line comprising various stations, programming of the firmware, e.g., Fig. 2, element 22, is at a first station, e.g., Fig. 5, element 84 when the pieces of the motherboard are being assembled) to enable the module to receive information via preselected wireless protocol (Paragraph 17, wireless protocol are open standards such as IEEE 802.11b); and thereafter downloading wirelessly new application and program software to a second portion of the module memory via the preselected wireless protocol (Paragraph 19, disclose downloading configuration information for drivers, OS, application software and the application software itself, all wirelessly; Fig. 2, element 42) at a second programming station (Fig. 5, element 88 is the second programming station where wireless download occurs).
7. Per claim 2, O'Connor discloses claim 1, wherein the wireless IEEE 802.11b protocol is by definition an open standard, the architect being the IEEE organization.

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8. Per claim 3, O'Connor discloses claim 1, wherein the firmware is inherently smaller than where the application software is stored, e.g., hard drive, flash drive, etc., since firmware comprises only the rudimentary data required for system operation, whereas application software has graphic data, user data, etc.

9. Per claim 4, O'Connor discloses claim 3, wherein it is well-known in the art that 802.11b has a transfer rate of 11Mbps, whereas wired programming of firmware via JTAG, e.g., via USB is known to go up to 8Mbps.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13. Claims 5-7 are rejected under 35 USC 103(a) as being unpatentable over O'Connor.

O'Connor discloses all the limitations of claim 1, further disclosing the computer being assembled is on a production assembly line (Fig. 4 and 5). O'Connor discloses the objective of begin able to download driver/configuration information for *peripheral devices* of the computer (Paragraph 19), e.g., for peripheral cards (Fig. 4, explicitly shows PCI/ISA cards). O'Connor discloses the download of configuration information at a second station (Fig. 2, element 42 and Fig. 5, element 88).

O'Connor does not disclose expressly the peripheral devices having flash memory and updating the flash memory at a second flashing station.

At the time of the invention it would have been obvious to a person of ordinary skill in the art to update the flash memory of a peripheral device at a second flashing station.

The suggestion/motivation for doing so would have been it being very well-known to one of ordinary skill in the art that the configuration/driver information of a peripheral card (e.g., the PCI/ISA card) resides on firmware of the peripheral card, the firmware intrinsically being flash/nonvolatile memory.

Therefore, it would have been obvious that during the wireless download of driver/configuration information by O'Connor (Paragraph 19) at a second station, the flash memory of the peripheral cards would be reprogrammed.

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14. Per claims 6 and 7, O'Connor discloses claims 1-4 which are directly applicable to these claims.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Patents and patent related publications are cited in the Notice of References Cited (Form PTO-892) attached to this action to further show the state of the art with respect to wireless reprogramming of nonvolatile memory.


16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alan S. Chen whose telephone number is 571-272-4143. The examiner can normally be reached on M-F 8:30am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim N. Huynh can be reached on (571) 272-4147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ASC

01/03/2006 


KIM HUYNH
SUPERVISORY PATENT EXAMINER

1/4/06